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UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re 7-Eleven, Inc.

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Serial No. 75/748,010

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Craig S. Fochler, Charles R. Mandly, Jr., Diane G. Elder  
and Lindsey D. Barnes of Wildman, Harrold, Allen & Dixon  
for 7-Eleven, Inc.

Georgia Ann Carty, Trademark Examining Attorney, Law Office  
111 (Craig Taylor, Managing Attorney).

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Before Seeherman, Hairston and Bottorff, Administrative  
Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

7-Eleven, Inc. has appealed from the final refusal of  
the Trademark Examining Attorney to register SUPER SLURPEE  
STRATA as a trademark for "semi-frozen soft drinks."<sup>1</sup> The  
Examining Attorney has made final a requirement that

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<sup>1</sup> Application Serial No. 75/748,010, filed July 12, 1999, based  
on an asserted bona fide intention to use the mark in commerce.

applicant disclaim the word SUPER, and has refused registration in the absence of such disclaimer.

The appeal has been fully briefed, but an oral hearing was not requested.

Section 6(a) of the Trademark Act, 15 U.S.C. 1056(a), provides that the Director may require the applicant to disclaim an unregistrable component of a mark otherwise registrable. Section 2(e)(1) of the Trademark Act, 15 U.S.C. 1052(e)(1), prohibits the registration of matter which, when used on or in connection with the goods of the applicant, is merely descriptive of them. A term is merely descriptive if it immediately conveys knowledge of the ingredients, qualities or characteristics of the goods with which it is used. See **In re Gyulay**, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987). Further, terms that are merely laudatory and descriptive of the alleged merit of a product are regarded as being descriptive. See **In re Consolidated Cigar Co.**, 35 USPQ2d 1290 (TTAB 1995).

The Examining Attorney asserts that the term SUPER in applicant's mark SUPER SLURPEE STRATA is a laudatory term which is merely descriptive and must be disclaimed. The Examining Attorney also asserts that the word SUPER in the mark "operates to quantify the nature of the applicant's goods," brief, p. 4, and that "the applicant's soft drink

goods are the type of goods that are commonly provided in optionally sized containers." Brief, p. 6. The Examining Attorney has submitted with her brief dictionary definitions<sup>2</sup> of "super" as meaning:

1. An article or a product of superior size, quality, or grade.
2. Very large, great, or extreme.
3. Excellent; first-rate.

Applicant relies heavily on **In re Ralston Purina Co.**, 191 USPQ 237 (TTAB 1976) in which the Board found that the term SUPER in the mark RALSTON SUPER SLUSH was not merely descriptive and did not need to be disclaimed. Applicant also points to two registrations it owns, for SUPER BIG GULP for "soft drinks for consumption on or off the

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<sup>2</sup> The American Heritage Dictionary of the English Language, 3d ed © 1992. The Board may take judicial notice of dictionary definitions. **University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc.**, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

In its reply brief applicant, referring to these dictionary definitions, notes that the Examining Attorney, in discussing the definitions, makes the statement, "SUPER [has] laudatory connotations in both the noun and adjective form," quoting p. 2 of the Examining Attorney's brief. Applicant then focuses on the Examining Attorney's use of the word "connotation," for which applicant has submitted a dictionary definition of "The suggesting of a meaning by a word apart from the thing it explicitly names or describes" to argue that the fact that "connotation" suggests a meaning shows that the word SUPER is suggestive. This argument is mere sophistry. To be clear, however, we explicitly state that we regard the dictionary definitions of "super" to be the meanings of the word, and not to show that "super" is only suggestive of those meanings.

premises"<sup>3</sup> and SUPER BIG BITE for "sandwiches, namely hot dogs and buns,"<sup>4</sup> which registered without a disclaimer of SUPER. Applicant has also argued that, because it owns a registration for SUPER SLURPEE for "flavored semi-frozen carbonated soft drinks for consumption on or off the premises,"<sup>5</sup> the Examining Attorney's present requirement for a disclaimer of SUPER is in the nature of a collateral attack on applicant's prior incontestable registration, and is precluded under the principles enunciated in **In re American Sail Training Association**, 230 USPQ 879 (TTAB 1986).

Looking to case law and past practice of the Office, the word SUPER has been found to be, in different contexts, either a suggestive word (and therefore eligible for inclusion as an undisclaimed element of a mark, or a descriptive word, and therefore a word which must be disclaimed or, if the only feature of a mark, ineligible for registration. In some registrations, the word SUPER is disclaimed; in others, it is not.<sup>6</sup> The same discrepancy

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<sup>3</sup> Registration No. 1,470,871.

<sup>4</sup> Registration No. 1,721,151.

<sup>5</sup> Registration No. 1,647,002.

<sup>6</sup> Thus, we give little weight to applicant's ownership of registrations for SUPER BIG GULP and SUPER BIG BITE, which issued without disclaimer of the word SUPER. As applicant itself has stated throughout the prosecution of the application and briefing of this appeal, "prior decisions respecting the registerability of other marks do not bind the Office when determining the

appears in published decisions, as the cases cited by applicant and the Examining Attorney show. See, for example, the cases reviewed in **In re Phillips-Van Heusen Corp.**, 63 USPQ2d 1047 (TTAB 2002), including **Quaker State Oil Refining Corp. v. Quaker Oil Corp.**, 453 F.2d 1296, 172 USPQ 361, 363 (CCPA 1972) [SUPER BLEND held merely descriptive of motor oils as designating "an allegedly superior blend of oils"]; **In re Consolidated Cigar Co.**, supra at 1293-94 [SUPER BUY found laudatory and hence merely descriptive of cigars, pipe tobacco, chewing tobacco and snuff inasmuch as term "ascribes a quality of superior value to the goods," in that they "are an exceptionally high value for their price," and is "an expression of pre-eminence, analogous to a grade designation"]; **In re Carter-Wallace, Inc.**, 222 USPQ 729, 730 (TTAB 1984) [SUPER GEL held merely descriptive of a lathering gel for shaving because term "would be perceived as nothing more than the name of the goods modified by a laudatory adjective indicating the superior quality of applicant's shaving gel"]; **In re Samuel Moore & Co.**, 195 USPQ 241 (TTAB 1977) [SUPERHOSE! found merely descriptive of hydraulic hose made

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registerability of the mark for which registration is sought," Brief, p. 6, and "each case must be determined on its own merits and the cited [registrations] are entitled to little or no weight", reply brief, p. 4.

of synthetic resinous materials inasumuch as term "would be understood as the name of the goods modified by a laudatory adjective which would be taken to mean that applicant's hose is of superior quality or strength"]; **In re Allen Electric & Equipment Co.**, 175 USPQ 176, 177 [SUPER COLLINEAR found neither descriptive nor misdescriptive of base station communication antennas inasmuch as "an antenna is either collinear or it is not" and thus "one antenna is not more collinear or it is not" and thus "one antenna is not more collinear than another nor would it be comparatively, most collinear of three or more such arrays; and **In re Occidental Petroleum Corp.**, 167 USPQ 128 (TTAB 1970) [SUPER IRON held suggestive of soil supplements because "it takes some roundabout reasoning to make a determination...that the product contains a larger amount of iron than most soil supplements or that this iron...ingredient...is superior in quality to iron found in other soil supplements"].

What is clear, after reviewing the various cases and third-party registrations, is that the question of whether the term SUPER is merely descriptive or is suggestive must be determined on a case-by-case basis, considering the marks, the goods, and the evidence of the particular record.

In this case, we find that SUPER is merely descriptive, and must be disclaimed. First, and most importantly, we note that applicant, in its prior registration for SUPER SLURPEE, disclaimed exclusive rights to the word SUPER.<sup>7</sup> This disclaimer is an acknowledgement by applicant of the descriptiveness of SUPER for its soft drink product.<sup>8</sup> See **Quaker State Oil Refining Corporation v. Quaker Oil Corporation**, supra, (when appellant disclaimed the term in applications for registrations of compound marks, it admitted the merely descriptive nature of the mark). Further, applicant has essentially admitted in its reply brief that the word is merely descriptive for these goods by its claim that "'super' has presumptively acquired distinctiveness through more than fifteen years of continuous use." Reply brief, p. 4. Only a term which was initially merely descriptive would acquire distinctiveness; otherwise it would be inherently distinctive.<sup>9</sup>

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<sup>7</sup> In view of this disclaimer, applicant's argument that the Examining Attorney's requirement for a disclaimer of SUPER in its present mark represents a collateral attack on the prior registration must fail.

<sup>8</sup> We point out that this registration issued on June 4, 1991, at a point when a disclaimer of matter which was arbitrary or otherwise registrable was not accepted. This policy, as it applied to voluntary disclaimers, was changed in **In re MCI Communications Corp.**, 21 USPQ2d 1534 (Comr. Pats. 1991).

<sup>9</sup> If applicant believes that the word SUPER in the mark SUPER SLURPEE STRATA has acquired distinctiveness as a result of its use of the mark SUPER SLURPEE, applicant would, of course, be

Further, we find that applicant's reliance on **In re Ralston Purina Company**, 191 USPQ 237 (TTAB 1976) is inapposite. In that case, the Board reversed the Examining Attorney's requirement that applicant disclaim the word SUPER in the mark RALSTON SUPER SLUSH (SLUSH disclaimed), for a concentrate for making a slush type soft drink. The Board stated, at p. 238, that, in the context of "modern day advertising where [the term] is used as mere puffery and product manufacturers use it, not to describe size or other attributes of the product, but merely to connote a vague desirable characteristic or quality allegedly connected with the product," it is not merely descriptive. [emphasis added]. Applicant asserts that, as in Ralston Purina, the term SUPER in SUPER SLURPEE STRATA for semi-frozen soft drinks is also mere puffery. However, the Ralston Purina decision specifically recognized that the word SUPER would be merely descriptive if it is used "to describe size" of the product. In this respect, the word SUPER in SUPER SLURPEE STRATA is also merely descriptive. It is common knowledge, and therefore a fact of which we can take judicial notice, that drinks such as applicant's identified "semi-frozen soft drinks" come in a variety of

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free to file an application for SUPER SLURPEE STRATA claiming acquired distinctiveness with respect to this term.

sizes. The dictionary definitions of "super" show that "super" means a product of superior size. Consumers would, thus, immediately recognize, upon seeing the mark SUPER SLURPEE STRATA for such beverages, that SUPER describes a drink that comes in a very large size.<sup>10</sup> The fact that applicant also owns a registration for SLURPEE STRATA for semi-frozen soft drinks<sup>11</sup> (as well as registrations for both SLURPEE<sup>12</sup> and SUPER SLURPEE<sup>13</sup> for flavored semi-frozen soft drinks) reinforces this understanding. Thus, we are not persuaded by applicant's argument that "there is neither evidence of record, nor, indeed, basis in fact, for the Trademark Examining Attorney's bald assertion that 'super'

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<sup>10</sup> We note that, at footnote one of applicant's reply brief, it objects to the Examining Attorney's argument that SUPER "operates to quantify the nature of applicant's goods," stating that this assertion was not previously made and therefore should be disregarded, citing Trademark Rule 2.142(d). Applicant is advised that Trademark Rule 2.142(d) provides that the record in the application should be complete prior to the filing of an appeal, and that the Board ordinarily will not consider additional evidence filed with the Board after an appeal is filed. A new argument is not evidence, and raising an argument for the first time does not contravene the provisions of this rule. Moreover, even if the Examining Attorney had not raised the argument that SUPER describes the size of the soft drink, the Board could still make such a finding. As long as the applicant has been properly apprised of the basis for the requirement or refusal (in this case that SUPER must be disclaimed because it is unregistrable under the provisions of Section 2(e)(1) of the Act), the Board is not required to adopt the Examining Attorney's reasoning or arguments in support of that refusal, but can affirm the requirement or refusal based on the Board's review of the evidence, case law, etc.

<sup>11</sup> Registration No. 2,265,759.

<sup>12</sup> Registration No. 829,177.

<sup>13</sup> Registration No. 1,647,002.

'operates to quantify the nature of applicant's goods.'" Reply brief, p. 3.

Applicant also argues that "one is at a loss to understand how one could 'quantify' the SLURPEENess of 7-Eleven's product with the term 'super'." Reply brief, p. 3. This argument is simply disingenuous. As stated above, SUPER quantifies applicant's SUPER SLURPEE STRATA soft drinks by describing that they are a larger or super-size version of applicant's SLURPEE STRATA soft drinks.

Decision: The requirement for a disclaimer is affirmed, and registration in the absence of such disclaimer is accordingly affirmed. However, if applicant submits the required disclaimer within thirty days of the mailing date of this decision, the decision will be set aside, and the application approved for publication.